

REMARKS

Claims 1-19 are pending after entry of this paper. Claims 1-19 have been rejected.

Claims 1-19 have been amended. Support for the amendments may be found throughout the instant specification and the claims as originally filed. Support for the term “fine-grained copper powder” may be found throughout the instant specification, for example in the abstract. No new matter has been added by these amendments.

Reconsideration and withdrawal of the pending rejections are respectfully requested.

Response to Objection to the Specification

Applicants have amended the specification at page 7 before line 22 to include the section heading “BRIEF DESCRIPTION OF THE DRAWING” in accordance with the suggestion of the Examiner on page 2 of the Office Action. Accordingly, applicants believe the objection to the specification is moot.

Response to Claim Objections

The Examiner has objected to claims 1-19 because it is allegedly not clear to the Examiner if the silver amalgam includes the fine-grained copper or if the fine-grained copper is separate from the amalgam. The Examiner states that what happens to the fine-grained copper is not clear. The Examiner further states that the claim is broad enough to include other substances

in the amalgam. Applicants respectfully assert that neither what happens to the fine-grained copper nor the breadth of the claim render the claim improper in any way, because the claims fully satisfy all requirements of 35 U.S.C. §112. Specifically, applicants respectfully assert that the instantly pending claims are fully supported by the specification, and clearly sets forth the metes and bounds of what the applicants considers to be the invention. Applicants therefore respectfully request withdrawal of the claim objections.

Response to Rejections under 35 U.S.C. §103

The Examiner has rejected claims 1-4, 7, and 14-17 under 35 U.S.C. §103(a) for allegedly being obvious over U.S. Patent No. 5,487,819 (“Everett”) in view of U.S. Patent No. 4,214,379 (“Peters et al.”) and as further evidenced by the “Grit and Microgrit Grading Conversion Chart” (“Chart”). As the “Chart” is applied only for the conversion of mesh size to microns, it is not germane to the discussion below, and is not specifically addressed.

The Examiner’s description of Everett is similar to the description set forth in the November 2, 2007 Office Action. The Examiner admits that Everett does not disclose how the silver is cemented on the elemental copper and that the silver generated is an amalgam, or that the copper is fine-grained. The Examiner has combined Everett with Peters et al., which allegedly discloses recovering silver by contacting a silver chloride solution with amalgams of various metals including copper and recovering silver from the formed silver amalgam. The Examiner concludes that it would have been obvious to recover silver using elemental copper, as allegedly taught by Everett, with the amalgamation process as allegedly taught by Peters et al., to arrive at the invention as instantly claimed. Applicants respectfully disagree.

Applicants have previously described Everett and Peters et al. in the January 31, 2008 Amendment, herein incorporated by reference. Applicants wish to address herein several of the Examiner's contentions.

The Examiner alleges that Everett teaches the recovery of silver using elemental copper. Everett does indeed disclose low current density electrowinning of silver onto a cathode using electrolysis, where the anode is made of copper. However, as set forth on page 6 of the January 31, 2008 Amendment, the silver amalgam in Everett is generated by electrowinning onto the titanium cathode. This disclosure does not meet the claim element of "precipitating silver amalgam onto the surface of fine-grained copper" as recited in claim 1, because the silver amalgam formed in Everett is not formed by precipitation and is not formed on a copper surface at all. Accordingly, Everett fails to teach or suggest the claimed element. Combining Everett with Peters et al. does not remedy this deficiency. As set forth on pages 7-8 of the January 31, 2008 Amendment, Peters et al. does not disclose "precipitating silver amalgam" at all. In contrast, Peters et al. discloses replacing the metal in the amalgam with silver (col. 1, lines 58-61). Accordingly, Everett and Peters et al. do not teach or suggest the claimed element of "precipitating silver amalgam onto a surface of fine-grained copper," neither alone nor in combination.

Additionally, applicants respectfully assert that Everett and Peters et al. are uncombinable references. Specifically, Everett discloses that the electrowinning of silver chloride solutions onto the titanium cathode forms a Cu/Hg/Ag amalgam (see, e.g., col. 12, lines 4-5). In contrast, Peters et al. expressly teaches away from Everett, stating that "very little silver can be cemented with the amalgam in the presence of cupric ions" (col. 2, lines 56-57 of Peters

et al.). In light of this contradiction, applicants respectfully assert that the combination of these two references is inoperable and not obvious.

In addressing the applicants' arguments set forth in the January 31, 2008 Amendment regarding the claim element of "precipitating silver amalgam," the Examiner has suggested that the way in which the silver amalgam is produced in Peters et al. is not currently relevant because "[t]he process in Peter[s] et al results in an amalgam containing silver, which is claimed." Applicants respectfully disagree. Indeed, the way in which silver amalgam is produced is absolutely central to the question of whether or not the claimed element is taught or suggested by the combination of cited references. The instant claims are drawn to a method which requires the step of "precipitating silver amalgam onto a surface of fine-grained copper." The instant claims are not drawn to a silver amalgam composition. Peters et al. does not disclose the step of "precipitating silver amalgam" as recited in the claim, neither alone nor in combination.

For the foregoing reasons, applicants respectfully request reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. §103(a) over Everett in view of Peters et al.

The Examiner has rejected dependent claims 8, 9, 12, and 13 under 35 U.S.C. §103(a) for allegedly being obvious over Everett and Peters et al. in further view of U.S. Patent No. 4,666,514 ("Bertha"). The Examiner has rejected dependent claims 8, 10, 12, and 13 under 35 U.S.C. §103(a) for allegedly being obvious over Everett and Peters et al. in further view of U.S. Patent No. 4,670,052 ("Stanley et al"). The Examiner has rejected dependent claims 8 and 11-13 under 35 U.S.C. §103(a) for allegedly being obvious over Everett and Peters et al. in

further view of Derwent Acc-No. 1983-789093 (GB 2118536, "Derwent"). As set forth in the January 31, 2008 Amendment, none of Bertha, Stanley et al., and Derwent remedy the deficiencies of Everett in view of Peters et al., as discussed above. Accordingly, applicants respectfully request withdrawal of the respective rejections under 35 U.S.C. §103(a).

Dependent Claims

Applicants have not independently addressed all of the rejections of the dependent claims. Applicants submit that for at least similar reasons as to why independent claim 1 from which all of the dependent claims 2-19 depend are believed allowable as discussed *supra*, the dependent claims are also allowable. The applicants however, reserve the right to address any individual rejections of the dependent claims and present independent bases for allowance for the dependent claims should such be necessary or appropriate.

Thus, applicants respectfully submit that the invention as recited in the claims as presented herein is allowable over the art of record, and respectfully request that the respective rejections be withdrawn.

CONCLUSION

Based on the foregoing amendments and remarks, applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application. Favorable action by the Examiner is earnestly solicited.

In the event that an interview would be helpful in advancing prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number below.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **13-4500**, Order No. 4819-4740.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. 4819-4740.

Respectfully submitted,
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